

## **REMARKS**

### **Status of Application**

Claims 1 and 3-13 are pending in the application. Claims 4 and 12 are objected to of informalities. Claims 1, 3-6 and 9-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lang et al. (US Patent 7,184,814). Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang et al. in view of Kido et al. (US Patent 5,732,149).

By this Amendment, Applicant is canceling claim 4, and amending claims 6 and 12.

### **Claim Objections**

*Claims 4 and 12 are objected to because of the following informalities: Claim 4 is objected to as being a duplicate of claim 3 and claim 12 contains an error.*

Applicant hereby cancels claim 4 in response to the Examiner's objection.

Applicant hereby amends claim 12 in order to cure the noted deficiency.

### **Claim Rejections - 35 U.S.C. § 102**

*Claims 1, 3-6 and 9-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lang et al. (US Patent 7,184,814).*

Claim 1 recites, in part, "an automatic diagnosis unit which outputs information on said predetermined part of said object, based on said characteristic quality." The Examiner alleges that Lang discloses all of the elements of claim 1. Applicant respectfully disagrees.

Lang discloses a method and apparatus for assessing the condition of a joint and assessing cartilage loss. Lang discloses that cartilage loss and movement patterns are determined separately, and optionally combined to determine a therapy pattern based on movement and wear

patterns of the cartilage. See FIG. 1 and col. 13, lines 19-40. The Examiner alleges that col. 29, lines 49-60 of Lang discloses the automatic diagnosis unit recited in claim 1. However, claim 1 recites that the automatic diagnosis unit outputs information ... based on said characteristic quality, the characteristic quality being determined by a positional relationship between the positions of interest found during movement of the part of an object. Col. 29, lines 49-60, on the other hand, indicate that a computer may determine cartilage condition based on biochemical information. See col. 27, line 26 - col. 29, line 60, "Display of Biochemical Information." Rather, while Lang indicates that movement of a joint is recorded, Lang fails to indicate that information on a predetermined part is outputted from an automatic diagnosis unit based on the movement. Therefore, Lang fails to disclose this aspect of claim 1.

Further, claim 1 recites, in part, "a position-of-interest determination unit which *determines a plurality of positions* ... to be positions of interest (emphasis added)." Lang discloses that a multitude of markers may be placed around a joint in order to find a pattern of movement. However, Lang does not *determine* a plurality of positions which are positions of interest. The user determines where the markers are placed, and these markers are used to track positions of the joint during movement. Therefore, Lang does not have a unit which *determines* which positions are positions of interest in an object during the object's movement. See new claim 14. Thus, claim 1 is patentable over the applied art.

Claims 3-6 and 9-13 are patentable at least by virtue of their dependency from claim 1.

Further, to the extent that the Examiner relies on the motion analysis described at cols. 31-35 to teach a marker used to investigate motion, Applicant submits that the cited portion relates to a biomechanical analysis, such as that provided by a camera. See col. 32, lines 43-45.

Therefore, the cited portion does not teach the multiple position radiological information as described by claims 4-8, for example. Conversely, the Examiner's reliance on any MRI information simply does not provide the positional information relative to movement as claimed. Therefore, claims 4-8 are patentable for this additional reason.

**Claim Rejections - 35 U.S.C. § 103**

*Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang et al. in view of Kido et al. (US Patent 5,732,149).*

Claims 7 and 8 are dependent from claim 1. Because Lang fails to disclose all of the aspects of claim 1, and because Kido fails to cure the noted deficiency in Lang with respect to claim 1, claims 7 and 8 are patentable at least by virtue of their dependency from claim 1.

**New Claims**

Applicant further adds new claims 14-21. Claims 14-21 depend from claim 1, and are patentable at least by virtue of their dependency therefrom.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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